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09/922,201	08/02/2001	Gregory Maurice Plow	STL920000037US1	1396

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EXAMINER

LASTRA, DANIEL

ART UNIT	PAPER NUMBER
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3622

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/922,201
Filing Date: August 02, 2001
Appellant(s): PLOW ET AL.

John L. Rogitz
For Appellant

EXAMINER'S ANSWER

MAILED

JUN 28 2005

GROUP 3600

This is in response to the appeal brief filed 03/29/2005.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of invention contained in the brief is correct.

(6) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(7) Prior Art of Record

5,913,040	RAKAVY ET AL	06-1999
6,615,248	SMITH	09-2003

(8) Ground of Rejection to be reviewed on Appeal

Claims 1, 2, 4, 8-12, 14, 16, 19-22, 26, 29 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Rakavy et al (U.S. 5,913,040).

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As per claim 1, 11, 12, 16, 22 and 26 Rakavy teaches:

A computer-method for selectively displaying Internet advertisements, comprising the acts of:

allowing a user to choose at least one advertisement channel from an advertisement channel menu presenting plural advertisement channels (see column 3, lines 1-44; column 9, line 15 – column 10, line 12);

displaying advertisements at least partially based on what channel is selected by the user (see column 3, lines 1-44; column 9, line 15 – column 10, line 12) and

displaying a menu of user definable advertising attributes (see column 9, lines 15-50; column 10, lines 21-40), wherein the user definable attributes include at least one of: advertisement type, city, zip code, retailers, distance of travel to a retailer, means for delivery, retail only, or wholesale only (see column 9, lines 15-50; Rakavy teaches advertisement type in column 3, lines 30-35 “choosing categories of advertising”; Rakavy teaches means for delivery in column 9, lines 42-45 when Rakavy recites that, “user preference information typically includes...b) time periods during which sound-only advertisement are to be played c) whether wallpaper or cursor advertisements are allowed” (see column 3, lines 30-35; column 9, lines 34-47; column 11, lines 45-58).

As per claims 2, 20 and 30, Rakavy teaches:

The method of Claim 1, further comprising the act of allowing the user to create an advertisement window in which advertisements are displayed (see column 11, lines 45-59).

As per claims 4 and 14, Rakavy teaches:

The method of Claim 1, further comprising the act of:

allowing the user to establish the values of the user definable attributes (see column 7, lines 42-67).

As per claim 8, Rakavy teaches:

The method of Claim 1, further comprising the act of displaying at least one advertisement corresponding to a user selected advertisement channel (see column 11, lines 45-57).

As per claims 9, 19 and 29, Rakavy teaches:

The method of Claim 1, wherein the advertisement channels menu includes at least one of: a travel advertisement channel, a food advertisement channel, an automotive advertisement channel, a clothing advertisement channel, a music advertisement channel, a movie advertisement channel, an antiques advertisement channel, a hardware advertisement channel, a sporting goods advertisement channel, a housewares advertisement channel, an art supplies advertisement channel (see column 9, lines 34-40).

Claims 10 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rakavy et al (U.S. 5,913,040) in view of Smith (U.S. 6,615,248).

As per claims 10 and 21, Rakavy teaches:

The method of Claim 1, but fails to teach wherein the advertisements are displayed at a device that receives Internet content and television broadcast content. Smith teaches a system that displays television programs and Internet content in a

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user's browser (see figures 4 and 5; column 5, lines 5-20; column 7, lines 25-45) and Rakavy teaches displaying advertisements in an Internet browser (see Rakavy column 1, lines 29-32). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Rakavy would use the system taught by Smith, to display television programs and Internet information in a browser. This feature would allow users to view television programs, while simultaneously searching for information via the Internet.

(9) Response to Arguments

The Appellant argues that the preamble of claims 1 and 30 are tied to the respective claim bodies by the recited "advertisements" in both, therefore, making the claims statutory. The Examiner answers that as the technological arts recited in its preamble, (A computer-implemented method for selectively displaying Internet advertisements) mere recitation in the preamble (i.e., intended or filed of use) or mere implications of employing a machine or article or manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble. Nothing in the body of the claim, recites any structure or functionality to suggest that a computer performs the recited steps of "allowing a user to choose at least one advertisement channel from an advertisement channel menu presenting plural advertisements channels; displaying advertisements at least partially based on what channel is selected by the user; displaying a menu of user definable advertising attributes, wherein the user definable attributes include at least one of: city, zip code,

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retailers, distance of travel to a retailer, means for delivery, retail only, or wholesale only". Therefore, the preamble is taken to merely recite a field of use.

The Appellant argues that Rakavy does not teach a user-defined city as an ad attribute or a user-defined zip code as an ad attribute or a user-defined retailers as an ad attribute or a user-defined distance of travel to a retailer as an ad attribute or a user-defined means for delivery as an ad attribute or a user-defined retail only as an ad attribute or a user-defined wholesale only as an ad attribute.

The Examiner answers that the Appellant's specification describes (in page 8, lines 19-22) a "user's preferred means for delivery" but does not explain what is it that is delivered. The Examiner would read "means for delivery" as means for delivery of advertisements to a user. Rakavy teaches (in column 9, lines 40-45) about a user-defined means for delivering advertisements to users when Rakavy recites that "user preference information typically includes...b) time periods during which sound-only advertisement are to be played c) whether wallpaper or cursor advertisements are allowed". In Rakavy, the user-defined ad attribute would be the means of delivering sound-only advertisements, or the means of delivering of wallpaper advertisement or the means of delivering cursor advertisement (see column 11, lines 45-58).

The Appellant argues that nothing in Rakavy motivates to display both TV and Internet advertising and that because Smith has nothing to do with advertisement at all, it cannot supply the motivation to combine.

The Examiner answers that nothing in Rakavy motivates to display both TV and Internet advertising and that, because Smith has nothing to do with advertisement at all, it cannot supply the motivation to combine. The Examiner answers that Appellant's

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claims 10 and 21 recite "wherein the advertisements are displayed at a device that receives Internet content and television broadcast content". And, Smith teaches a system that displays television programs and Internet content in a user's browser (see Smith figures 4 and 5; column 7, lines 25-45) and Rakavy teaches displaying advertisements or Internet content in a user's browser (see Rakavy column 1, lines 29-32; column 5, lines 7-20). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Rakavy would use the system taught by Smith, to display television programs and Internet information in a browser. This feature would allow users to view television programs, while simultaneously searching for information via the Internet.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Daniel Lastra DL

June 23, 2005

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